

### **REMARKS**

The Examiner's Action of June 24, 2003 has been received and its contents carefully considered. Reconsideration is respectfully requested in view of the instant Submission, including Amendments and Remarks.

Claims 49, 53, 56 and 57 have been amended. New claim 60 is being submitted. Claims 49-60 are currently pending in the instant application.

#### **I. Personal Interview**

Applicant's representative, Laleh Jalali, would like to thank the Examiner for the courtesies extended during a personal interview on August 5, 2003 ("the personal interview"), during which the objections and rejections in the Office Action of June 24, 2003 were discussed. The instant Response is being filed as a result of the personal interview, and the Remarks herein refer to the substance of the personal interview in greater detail where relevant.

#### **II. Objection under 35 USC 132**

The specification has been objected to under 35 USC 132 for introducing new matter into the disclosure. Specifically, the Examiner objects to use of the phrase "substantially parallel to the flat surfaces of the shingle." Reconsideration is respectfully requested in view of the amendment and the following comments.

It is Applicant's view that the above phrase is fully supported in the original disclosure. The above notwithstanding, the above phrase has been removed without prejudice from the specification in the instant response, thus obviating the objection under 35 USC 132 as discussed and agreed upon during the personal interview.

### **III. Objection to the Disclosure**

The disclosure has been objected to at paragraph 11 since that paragraph still used reference numeral 10 to refer to the pliers and to the plate. In response, paragraph 11 has been amended herein where appropriate to address the informality noted by the Examiner.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw his objection to the disclosure.

### **IV. Rejections under Section 112, First Paragraph**

Claims 49-59 have been rejected under the first paragraph of Section 112 as failing to comply with the written description requirement. In particular, the Examiner reiterates his position previously set forth in the objection to the specification under 35 USC 132 discussed above that a force applied “substantially parallel” to the flat surfaces of the shingle constitutes new matter. Reconsideration is respectfully requested in view of the amendment and the following comments.

As set forth in Section I above, it is Applicant’s view that the above phrase is fully supported in the original disclosure. The above notwithstanding, the above phrase has been removed without prejudice from the claims in the instant response, thus obviating the rejection under 35 USC 112, first paragraph, as discussed and agreed upon during the personal interview. The Examiner is, therefore, respectfully requested to reconsider and withdraw the rejection.

### **V. Rejections under 35 USC 112, Second Paragraph**

Claim 53 has been rejected under the second paragraph of Section 112 for being indefinite. In particular, the Examiner objects to the use of the language “one of fixedly and pivotally attached” as indicating that the attachment is both fixed and pivotal. Reconsideration is respectfully requested in view of the amendment and the following comments.

Applicant submits that the above-quoted language clearly denotes that the attachment may be either fixed or pivotal, and that the claim therefore is a claim containing alternative language. The above notwithstanding, however, claim 53 has been amended to be directed to a fixed attachment, while a new claim 60 has been added to claim a pivotal attachment of the upper plate to the upper jaw.

As discussed and agreed upon during the personal interview, it is noted that the above amendments overcome the rejection of claim 53 under the second paragraph of Section 112. The Examiner is, therefore, respectfully requested to reconsider and withdraw the rejection.

**VI. Rejection under 35 USC 102(b)**

Claims 49-52, 54 and 55 have been rejected under Section 102(b) as being anticipated by Small. Reconsideration is respectfully requested in view of the amendment and the following comments.

Small does not disclose, or even suggest an apparatus as recited in independent claim 49 for gripping and removing a shingle fixed to a support comprising:

- an upper gripping member defining a substantially flat first gripping surface;
- a lower gripping member defining a substantially flat second gripping surface;
- a gripping mechanism connecting the upper and lower gripping members to one another, the gripping mechanism being configured for urging the gripping members toward one another for gripping the shingle therebetween; and
- an impact transmitting member connected to the gripping mechanism, the impact transmitting member being configured for transmitting an impact to both the upper and lower gripping members for removing the shingle from the support when the shingle is gripped between the upper and lower gripping members;

wherein:

- the first and second gripping surfaces are configured and disposed relative to one another such that, when the apparatus grips the shingle, each of the first and second gripping surfaces applies a force evenly distributed along an entire width thereof.

As discussed and agreed upon during the personal interview, the above features are neither disclosed nor suggested by Small. It is further noted that the above features are neither disclosed nor suggested by any other one of the cited references.

Accordingly, it is submitted that independent claim 49 is patentable over Small. In addition, it is submitted that dependent claims 51-55 and 60 are likewise patentable over Small for being dependent on claim 49, and further for the particular additional features that they recite.

In view of the above, the Examiner is respectfully requested to reconsider and withdraw his rejection of the claims under Section 102(b).

**VII. Rejection under 35 USC 103(a)**

Claims 56-59 have been rejected under Section 103(a) as being unpatentable over Small. Reconsideration is respectfully requested in view of the amendment and the following comments.

Small neither discloses nor suggests method for removing a shingle fixed to a support comprising:

gripping the shingle between a first flat gripping surface and a second flat gripping surface of respective upper and lower gripping members of a gripping apparatus such that each of the first and second flat gripping surfaces applies a force evenly distributed along an entire width thereof; and

transmitting an impact to both the upper and lower gripping when the shingle is gripped there between for removing the shingle from the support.

As discussed and agreed upon during the personal interview, the above method steps are not disclosed or even suggested by Small. It is further noted that the above method steps are neither disclosed nor suggested by any other one of the cited references.

Accordingly, it is submitted that independent claim 56 is patentable over Small. In addition, it is submitted that dependent claims 57-59 are likewise patentable over Small for being dependent on claim 56, and further for the particular additional features that they recite.

In view of the above, the Examiner is respectfully requested to reconsider and withdraw his rejection of the claims under Section 103(a).

**VIII. Allowable Subject Matter**

The prior art references, either alone or in combination, fail to disclose or even suggest an apparatus configured for gripping a shingle and for removing the shingle by virtue of the application of an impact force.


CONCLUSION

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration, withdrawal of all grounds of rejection and issuance of a Notice of Allowance are solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600. The Examiner is invited to contact the undersigned at (202) 220-4296 to discuss any matter regarding this application.

Respectfully submitted,  
KENYON & KENYON

Date: August 26, 2003

  
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